

REMARKS

This Application has been carefully reviewed in light of the *Office Action*. At the time of the *Office Action*, Claims 40-69 were pending of which the Examiner rejected Claims 40-69. Applicants have canceled Claims 45, 58-61, and 64, amended Claims 40-44, 46, 57, 62, 63, and 65-69, added a new claim, Claim 70. Applicants respectfully request reconsideration and favorable action in this case.

Section 112 Rejections of Claims 1, 3-8, 12-17, 19-23, 27-33, and 36-39

The *Office Action* rejects Claims 40-69 under 35 U.S.C. § 112, first paragraph, contending that these claims fail to comply with the written description requirement. In particular, the Examiner states, “Applicant has claimed ‘a majority’ throughout the claims . . . [but] [n]o support was found in the specification for all the features over a ‘majority’ of the device. Majority is defined as more than 50 percent.” See *Office Action*, page 2. Applicants respectfully traverse these rejections for the reasons stated below.

According to the M.P.E.P., the standard for determining compliance with § 112 first paragraph is whether “the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” See § 2163.03. In other words, “[t]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Id.* (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). Possession may be shown in a variety of ways including “descriptive means [such] as words, structures, figures, diagrams, and formulas.” *Id.*

At least according to this standard, Applicants respectfully contend that the disclosure “reasonably conveys to the artisan that the inventor had possession” of claims directed to features over a majority of the device. See e.g., Fig. 1A and 1B. Accordingly, Applicants respectfully request the Examiner to withdraw his rejection of Claims 40-44, 46, 57, 62, 63, and 65-69 under 35 U.S.C. § 112. Additionally, Claims 45, 58-61, and 64 have been canceled, thereby rendering the Examiner’s rejections of these claims under these grounds moot.

Additionally, the Examiner rejects claims 48 and 63 as reciting a range that is not recited in the specification. Specifically, the Examiner states, “[a] ratio of the crest width to

the pitch is between 0.25 and 0.4 . . . is not the range found recited in the specification and this is being considered new matter.” See *Office Action*, page 2. However, the specification discloses “in certain embodiments, the ratio of crest width 58 to pitch 52 is between approximately 0.2 and 0.4 . In the embodiment shown . . . the ratio of crest width 58 to pitch 52 is approximately 0.25.” See Application, page 9, lines 17-18. Applicants respectfully direct the Examiner’s attention to the above-stated standard for compliance with § 112 and traverse this rejection. The M.P.E.P. states, “[t]he subject matter of the claim need not be described literally . . . in order for the disclosure to satisfy the description requirement.” § 2163.02. Accordingly, Applicants respectfully contend that the disclosure “reasonably conveys to the artisan that the inventor had possession” of the ranges claimed and respectfully request the Examiner to withdraw his rejection of Claim 48 under 35 U.S.C. § 112. Additionally, Claim 63 has been canceled, thereby rendering the Examiner’s rejection of this claim under these grounds moot.

Section 102 Rejections

The *Office Action* rejects Claims 40-45 and 55-60 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,961,524 to Crombie (“*Crombie*”). The *Office Action* further rejects Claims 40-42 and 55-57 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,607,304 to Bailey et al. (“*Bailey*”). The *Office Action* further rejects Claims 40-42 and 55-57 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,704,750 to Bartos et al. (“*Bartos*”). Applicants respectfully traverse these rejections for the reasons stated below.

Claim 40, as amended, is directed to a medical implant that includes a body adapted for implantation into a sinus tarsi of a subtalar joint in a human foot. The body includes a first end having a first diameter and a second end having a second diameter. The body further includes at least one continuous and uninterrupted thread including a crest with a substantially flat surface and having a substantially constant thread height and helically traversing a length of an exterior surface of the body. Furthermore, the length spans from the first end to the second end. The body further includes a recessed engagement in the first end. Additionally, a circumference of the exterior surface tapers from the first diameter to the second diameter along the length of the body. Additionally, Claims 55 and 67 contain limitations generally directed to at least one continuous and uninterrupted thread including a

crest with a substantially flat surface and having a substantially constant thread height and helically traversing a length of an exterior surface of the body wherein the length spans from the first end to the second end. Neither *Crombie*, *Bailey*, nor *Bartos* (collectively, the “*References*”) teach each of these limitations.

For example, Claim 40 recites “at least one continuous and uninterrupted thread including a crest with a substantially flat surface and having a substantially constant thread height and helically traversing a length of an exterior surface of the body, the length spanning from the first end to the second end.” None of the *References* disclose a “thread including a crest with a substantially flat surface and having a substantially constant thread height and helically traversing a length of an exterior surface of the body” wherein the “length” spans “from the first end to the second end.” Accordingly, Applicants respectfully contend that Claim 40 and all claims depending therefrom are in condition for allowance. For similar reasons, Applicants contend that Claims 55 and 67 and all of their dependent claims are in condition for allowance.

Additionally, Claim 41 is directed to the medical implant of Claim 40 wherein “the circumference of the exterior surface tapers uniformly from the first end to the second end according to a predetermined taper angle.” None of the *References* disclose a “circumference” that “tapers uniformly from the first end to the second end according to a predetermined taper angle.” Accordingly, Applicants respectfully contend that Claim 41 is in condition for allowance.

Additionally, Claim 54 is directed to the medical implant of Claim 40 further comprising “a bore coaxial with the recessed engagement and extending from the recessed engagement to the second end.” None of the *References* disclose a “bore.” Accordingly, Applicants respectfully contend that Claim 54 is in condition for allowance.

For at least the reasons stated above, Applicants respectfully contend that all claims are in condition for allowance.

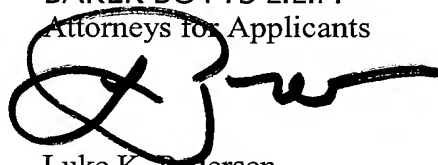
Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is authorized to charge the amount of **\$210.00** for the addition of one independent claim, **\$810.00** RCE fee, and to the extent necessary, charge any additional required fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Luke K. Pedersen
Reg. No. 45,003
PHONE: (214) 953-6655

Date: 10/31/07

CORRESPONDENCE ADDRESS:

Customer Number: **05073**